

REMARKS

The Applicants respectfully request further examination and consideration in view of the and arguments set forth fully below. Within the Office Action, Claims 1-11, 16 and 17 were allowed and Claims 12, 13, 15 and 18 were rejected. Therefore, Claims 1-12, 13, and 15-18 are pending in this application.

Claims 12, 13, 15 and 18

It is stated within the Office Action that Claims 12, 13, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK 2,339,834 to Rabenecker in view of U.S. Patent No. 5,890,634 to Zuckerman et al. (hereinafter Zuckerman) and U.S. Patent No. 3,383,963 to Vondrachek (hereinafter Vondrachek). Specifically, it is stated within the Office Action that it would have been obvious to modify the nubbed adapter in Rabenecker so that the adapter bar is flat, as in Zuckerman, and has an extending feature centered along its width dimension as in Vondrachek. The Applicants respectfully disagree.

The present invention at issue is directed to an adapter which is removably coupled to the clip. It is preferred that the adapter extends out from the inside surface of the clip past the notch to provide a smooth surface on the inside of the clip. The adapter is preferably made of a frictional material which secures the article. The adapter includes a feature located substantially in the center of the adapter surface and extends from the adapter surface toward the inner surface of the clip. The feature frictionally fits within an aperture in the inner surface of the clip, thereby securing the adapter to the clip.

Rabenecker teaches a measuring instrument with a holder 1, whereby the holder secures the measuring instrument to the belt of the user. Rabenecker teaches a plate 8 which couples to the measuring instrument, whereby the plate 8 includes two apertures or cut outs 13, 14 which extend through the plate 8. Rabenecker teaches that a knob strip made of foam rubber is buttoned into the cut outs 13, 14 of the plate 8. Specifically, as shown in Figures 1 and 2, the strip is U-shaped and has two ends which are inserted through the apertures 13, 14 of the plate to couple the strip to the plate 8. As shown in Figure 2, when the U-shaped strip is coupled to the plate 8, the ends of the U-shaped strip protrude as bumps along the inner surface of the plate 8 toward the housing 6 of the measuring instrument to provide an increased frictional force upon a fabric being clipped. Rabenecker also teaches that the strip may be removed to fasten the measuring instrument 7 to thicker fabrics or belts. To remove the U-shaped strip, the U-shaped

strip is pulled away from the plate 8, whereby the ends of the U-shape strip are pulled out from the apertures 13, 14 thereby leaving a flat inner surface of the plate 8.

Zuckerman teaches a clamp-type garment hanger which includes at least two clamp assemblies 20 for securing a garment. Each clamp assembly 20 includes a pair of removeable clamping members, whereby at least one clamping member has an inner clamping surface defined at least in part by at least one gripping pad. One side of the gripping pad includes a pair of clamping features 58 which clip into a corresponding pair of slots 52 in the clamping member 20. The pair of clamping features 58 are spaced apart from the center of the adapter to provide enough room for a U-shaped clamp 30 to slide into and out-of the slot 32 to lock and unlock the clamping assembly, respectively.

Vondrachek teaches a wrench which obtains a tight purchase on an object from any given angle. The wrench in Vondrachek has a pair of moveable jaws arms with a supplemental V-shaped jaw feature swivelly mounted within one of the jaw arms. In particular, the wrench has an aperture within which accepts a shank that protrudes out from the V-shaped jaw feature. The V-shaped jaw feature is coupled to the wrench by inserting the shank member 22 into the aperture in the wrench, whereby the shank 22, when inserted within the aperture, allows the V-shaped jaw feature to rotate about an axis through the shank 22.

In order to support a prima facie rejection for obviousness, the following tenets of patent law must be adhered to: 1) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; 2) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 3) reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co.*, 786 F.2d 1136 (Fed Cir. 1986). If any one of these elements is not met, the obviousness rejection cannot stand. Regarding the first requirement, "it is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed Cir. 1997). The fact that the prior art references can be combined is insufficient to meet the obviousness standard. *In re Mills*, 916 F.2d 680 (Fed Cir. 1990). "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350 (Fed Cir. 1998).

In the present case, there is no hint, teaching or suggestion to combine Zuckerman with Rabenecker and Vondrachek together to reach the present invention. As stated above,

Rabenecker teaches that the foam rubber strip is U-shaped and has two ends which are inserted through the two circular cut outs 13, 14 in the plate to engage the strip to the plate 8 (Figures 1 and 2). Thus, the U-shaped strip bar is pressed flat against the outer surface of the plate 8 (Figure 2) when the two ends of the U-shaped strip bar are positioned through the apertures 13, 14 to protrude from the inner surface of the plate 8 toward the housing 6 of the measuring instrument. The protrusions in the inner surface of the plate 8 are round, bump like features which are removeable by pulling the U-shaped strip away from the outer surface of the plate 8 to allow the measuring instrument to fasten to thicker materials and belts. The essence of the design of the plate 8 and U-shaped strip in Rabenecker allows the ends of the U-shape strip to protrude from the inner surface of the plate 8 to secure a garment, whereby the strip is applied to the plate 8 from the outer surface of the plate 8. In other words, inserting the ends of the U-shaped strip into the apertures 13, 14 from the inner surface of the Rabenecker plate 8, as taught by Zuckerman, would defeat the use applying the U-shaped strip entirely, because the flat portion of the strip would be pressed up against the inner surface of the plate 8 and would not apply any additional friction to the garment.

As stated above, Vondrachek teaches using rotatable V-shaped jaws to hold, twist or turn an object from any accessible angle. The rotatable V-shaped jaws are coupled to the wrench by inserting the shank 22, which extends from the center of the jaw, into a corresponding aperture in the wrench. In contrast, the adapters in Rabenecker and Zuckerman have a pair of engaging extensions which are positioned a certain distance away from the center of the adapter. In addition, Vondrachek teaches away from Rabenecker and Zuckerman, because from the V-shaped jaw member would not be able to rotate or swivel about its center if it were to be modified to have two shanks 22 as taught by Rabenecker and Zuckerman. Additionally, the adapter in Zuckerman would not be able to be coupled to the clamping assembly 20 if it only had one protrusion 54 which extended from its center, because the protrusion 54 would interfere with the lock 30, which is positioned in the center of the clamping assembly 20. Thus, there is no reasonable expectation of success in combining Vondrachek with Rabenecker and Zuckerman. *Hodosh*. Furthermore, Vondrachek does not solve the problem of securing a delicate article of clothing, because the gripping element in Vondrachek is a V shaped jaw element. Accordingly, Vondrachek, considered as a whole, does not suggest the desirability of utilizing V-shaped jaw element to secure delicate articles of clothing, as taught by Zuckerman. *Id*. Accordingly, one skilled in the art would not combine Rabenecker, Zuckerman and Vondrachek, individually or in combination to reach the present invention.

Claim 12 recites an adapter for providing a flat surface to a clip, wherein the clip is coupled to an object and having a segment which secures the object to an article worn by a person, the object having a surface adapted to be worn adjacent to the person, the adapter coupled to the segment and positioned between the segment and the surface of the object, wherein the adapter has an adapter length and an extending feature for removably coupling the adapter to the segment, the extending feature substantially centered along a width dimension on an interface surface of the adapter. As stated above, one skilled in the art, upon viewing Rabenecker and Zuckerman, would have no motivation to modify the U-shaped strip to provide a flat surface along the inner surface of the plate 8. The essence in the design of the plate 8 and U-shaped strip in Rabenecker allows the ends of the U-shape strip to protrude from the inner surface of the plate 8 to secure a garment. In other words, providing an adapter to the inner surface of the Rabenecker plate, as taught by Zuckerman, would defeat the use of the U-shaped strip entirely. In addition, Vondrachek teaches away from Rabenecker and Zuckerman, because from the jaw member in Vondrachek would not be able to rotate or swivel about its center if it were to be modified to have two shanks 22 as taught in Rabenecker and Zuckerman, to couple the jaw member to an accepting surface. Additionally, the adapter in Zuckerman would not be able to be coupled to the clamping assembly 20 if it only had one protrusion 54 which extended from its center, as taught in Vondrachek, because the protrusion 54 would interfere with the lock 30, which is positioned in the center of the clamping assembly 20. Thus, there is no reasonable expectation of success in combining Vondrachek with Rabenecker and Zuckerman. Nonetheless, one skilled in the art would not even find Vondrachek relevant to Zuckerman nor Rabenecker and would have no motivation to combine Vondrachek with Zuckerman and Rabenecker to reach the present invention. Vondrachek utilizes is a pair of V shaped jaw elements which are coupled to a pair of pliers. There is no mention in Vondrachek of providing a flat surface to a clip nor is there any mention that the V-shaped jaws are used to securing clothing without damaging the clothing. Vondrachek is in no way analogous art to the present invention nor Rabenecker and Zuckerman, because the V-shaped jaws of Vondrachek would harm or ruin any sort of clothing which the jaws would apply force onto. For at least these reasons, there is no motivation to combine Rabenecker, Zuckerman, and Vondrachek, individually or in combination, to reach the invention as claimed in Claim 12.

Claims 13, 15 and 18 are also rejected as being obvious over Rabenecker in view of Zuckerman and Vondrachek. Claims 13, 15 and 18 are dependent on an allowable Independent Claim 12. As stated above, Claim 12 is in a condition for allowance. Accordingly, Claims 13, 15 and 18 are also in a condition for allowance for being dependent on an allowable base claim.

For the reasons given above, the Applicants respectfully submit that the Claims 12, 13, 15, and 18 are in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, the Examiner is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: 8-28-03

By: Thomas B. Haverstock

Thomas B. Haverstock

Reg. No.: 32,571

Attorneys for Applicants

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